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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,059	01/08/2002	Manfred Spies	tesa AG 1513-WCG	4991

27386 7590 08/25/2003
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EXAMINER

ZIRKER, DANIEL R.

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 1-16 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11, 14-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☒ All ☐ Some* ☐ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received
in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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1. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 5, 7, 9, 11, 14 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, despite the recent claim amendments quite a few problems still remain. In claim 2, line 2 "low" and "high" ammonia is unduly vague and indefinite, and the Examiner further finds the usage of "type" here and elsewhere to be clearly informal. In claim 3, lines 2 and 3, "different" is unduly vague and indefinite; particularly at the molecular level all chemical compositions are "different". In claim 5, line 2, the phrase "EBC" is unfamiliar to the Examiner. Claim 7 should utilize proper Markush language and in claim 9, line 2 the phrase "physically surface treated" is not understood, and the phrase "pretreated" with a primer is believed more desirably stated such as --coated with a primer--. In claims 11 and 15 the phrase "total solids content" appears to lack antecedent basis. In claim 14, line 3 the phrase "other metal" is clearly vague and indefinite.

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2A. Applicants should amend the specification to provide proper support for newly presented claim 16, which formerly appeared to find proper support only in now cancelled claim 13.

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 and 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 1103587A2 Patent Abstract taken in view of EP 0688843A1, the application number of which is cited on page 2 of applicants' specification. The primary reference appears to disclose the identical embodiment ^{for} ~~to~~ at least applicants' broad independent claim except that a resin dispersion is utilized instead of applicants' claimed blend with a natural rubber latex before being coated and then dried; the reference being an example of ~~one of~~ the co-inventor Spies earlier work. The secondary reference, however discloses (note particularly page 2, lines 1-45) the fact that such adhesives often comprise natural or synthetic rubbers, with a significant amount of the solids content comprising rubber, together with

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such ingredients as resins, curing agents, antioxidants, fillers and the like, as well as tackifiers. Accordingly, one of ordinary skill, motivated by an expectation of improved adhesive performance properties would either incorporate or substitute the natural rubber taught by EP -843 into the ^{resin containing} blend with the butadiene/acrylate dispersion taught by EP -587 and thereby form the claimed adhesive composition and accompanying genus of adhesive tapes. With respect to the dependent claims, these are believed to involve ingredients, treatments and the like which are either expressly taught by the secondary reference or are believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also Spies, Spies et al. PG Pub, Lee, Makati et al. and Takemoto et al.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (703) 308-0031. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (703) 308-2414. The fax phone number for this Group is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Dzirker:cdc

August 19, 2003

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~

1700

Daniel Zirker